

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ranjan PERERA, <i>et al.</i>) Group Art Unit: 1636
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U.S. Patent Application No.: 10/702,319) Examiner: Qian, Celine X.
)
Filed: November 6, 2003) Confirmation No.: 7997
)
For: Compositions and Methods for the)
Modification of Gene Expression)

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COMMISSIONER FOR PATENTS
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AMENDMENT AND REPLY TO FINAL REJECTION
UNDER 37 C.F.R. §1.116 AND ADVISORY ACTION

This paper is responsive to the Final Rejection dated December 11, 2009 and the Advisory Action dated May 27, 2010 mailed in the above-reference application. With its previous response after final rejection filed on May 11, 2010, Applicants concurrently filed a Notice of Appeal and the appropriate fee. Thus, the response due date was July 11, 2010. Applicants request a four-month extension of time to extend the response date to November 11, 2010, which was a Federal holiday, thus making today, November 12, 2010, within the statutory period, and therefore this response is timely filed.

Remarks/Arguments begin on page 2 of this paper.

REMARKS

The final rejection dated December 11, 2009 and the Advisory Action dated May 27, 2010 have been carefully reviewed and the following remarks are made in response thereto.

Claims 22-40 are presently pending in the application. Because no amendments are being made to the claims at the time, this response does not include a new claim listing.

Applicants acknowledge the Examiner's withdrawal of the previous rejection of claims 38 and 40 under 35 U.S.C. § 112, 1st paragraph, in the Advisory Action. Therefore, the obviousness-type double patenting rejection is the only outstanding rejection.

Obviousness-type Double Patenting

Claims 22-40 remain rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,365,186 ("the '186 patent").

In an effort to expedite prosecution, Applicants herewith enclose a terminal disclaimer over the '186 patent to overcome this obviousness-type double patenting rejection.

Also enclosed is an assignment of patent rights in the present patent application. The present application was previously co-owned by Rubicon Forests Holdings Limited and ArborGen Inc. The enclosed assignment transfers Rubicon Forests Holding Limited's rights in the present application to ArborGen Inc. (formerly ArborGen LLC) so that ArborGen Inc. now holds the entire rights in the present application. Therefore, the present application and the '186 are commonly owned, and the terminal disclaimer should be accepted and its submission obviates the obviousness-type double patenting rejection.

In view of the filing of the terminal disclaimer and the assignment so that the present application and the '186 patent are commonly owned, Applicants submit that the obviousness-type double patenting rejection has been overcome, and this rejection of Claims 22-40 should be withdrawn.

CONCLUSION

This reply is fully responsive to the Office Action dated December 11, 2009 and the Advisory Action dated May 27, 2010. This response should be accepted and considered because it does not raise any new issues, and in fact, reduces issues on appeal.

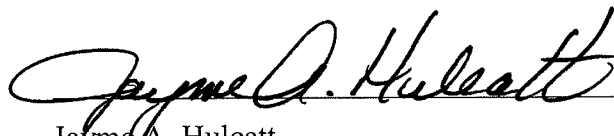
In view of the above remarks and the filed documents, it is believed that the present set of claims are now in condition for allowance. As noted in the Advisory Action, the Examiner states that Claims 22-40 are otherwise allowable but for the obviousness-type double patenting rejection. If, in the opinion of the Examiner, a further telephonic conference would expedite any minor issues with regard to the pending claims, the Examiner is invited to call the undersigned practitioner.

While it is believed that no additional fees are due, except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-1283.

Respectfully submitted,

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Dated: November 12, 2010



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